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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
			EXAMINER PHILPOTT, JUSTIN M	
			ART UNIT 2616	PAPER NUMBER

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/323,135

Applicant(s)

LAROQUE ET AL.

Examiner

Justin M. Philpott

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 16-27 of the Appeal Brief, filed April 26, 2006, with respect to claims 1-8 and 11-13 have been fully considered and are persuasive. The prior art rejection of these claims has been withdrawn. Accordingly, the finality of the rejection of the claims discussed above is withdrawn.
2. However, upon further consideration, a new ground(s) of rejection of claims 1-8 and 11-13 is made in view of Glass and Hartmann. Also, claims 12 and 13 remain rejected under 35 U.S.C. 112, first paragraph for reasons discussed below. Prosecution is hereby reopened.
3. Regarding the rejection of claims 12 and 13 under 35 U.S.C. 112, first paragraph, in applicant's Appeal Brief filed April 26, 2006, applicant argues that "[t]he Examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in the Appellant's disclosure a description of the invention defined by the claims. MPEP 2163.04". This reference by applicant, however, is either misplaced or incomplete. (Note, applicant's quote is found in the section I.A. of MPEP 2163 regarding "Original Claims", however, applicant's claims 12 and 13 are newly added claims that should instead be analyzed under section I.B regarding "New or Amended Claims"). The MPEP recites the following:

There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96; however, with respect to newly added or amended claims, applicant should show support in the original disclosure for the new or amended claims. See MPEP § 714.02 and § 2163.06 ("Applicant should specifically

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point out the support for any amendments made to the disclosure.”); and MPEP § 2163.04 (“If applicant amends the claims and points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.”). MPEP 2163, Section II.

Claims 12 and 13 were added by applicant as *new* claims in the amendment filed September 15, 2004. Applicant *failed to reference* any portion of the originally filed specification or drawings for support of the newly claimed subject matter at the time of the amendment. In response to the amendment, Examiner rejected the claims under 35 U.S.C. 112, first paragraph in the office action mailed December 2, 2004 because the newly claimed subject matter was not enabled by applicant’s originally filed specification. Applicant responded to this rejection on March 2, 2005 arguing that steps 26 and 27 of Figure 2 enable both claims 12 and 13. However, it remains Examiner’s position that the limitation of claims 12 and 13, “replac[ing] the receive flag ... regardless of the destination for the signaling message” [claim 12] and “regardless of the signaling configuration of said signaling message” [claim 13] is not supported by applicant’s specification or drawings. In particular, applicant’s argument that step 26 (labeled “Destination ?”) with outcomes “Here” or “destination not here” and result 27 (labeled “Process”) of Figure 2 teach these limitations are not persuasive. First, these references do not relate to “signaling configuration of [the] signaling message”. One of ordinary skill in the art would not find that checking a destination in a message explicitly or implicitly teaches or in any way suggests such checking relates to, let alone enables, a finding that the signaling configuration of the message is or is not considered. Accordingly, this portion of applicant’s

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invention does *not* teach “replac[ing] the receive flag ... regardless of the *signaling configuration* of said signaling message” (emphases added) as recited in claim 13. Additionally, these references teach replacing the flag only when a destination address does not match the destination. That is, the specification does *not* teach or imply replacement “regardless of the destination” as recited in new claim 12, but rather considers the destination *pertinent* to determining whether to replace the flag. (See specifically Figure 2, steps 26-28 and corresponding description in the specification).

Therefore, the disclosure does not reasonably convey that the inventor had possession of the subject matter of the later added claim 13 at the time of filing the application. Following the above-referenced passage of the MPEP, the Examiner has met the Office’s initial burden of proof, and such burden has shifted back to applicant to show how applicant’s specification enables the limitations of claims 12 and 13.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Specifically, claims 12 and 13 recite the limitation “regardless of the destination for the signaling message” and “regardless of the signaling configuration of said signaling message”, respectively. This limitation is not enabled by applicant’s specification.

Applicant may overcome this rejection by amending the claim to remove the above limitation. However, if amended in this manner, claim 13 would be objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim, claim 12. Thus, claim 13 should be canceled.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,995,595 to Hickey et al. in view of U.S. Patent No. 5,715,241 to Glass, III et al., further in view of U.S. Patent No. 6,516,355 to Hartmann et al.

Regarding claim 1, Hickey teaches a switch (e.g., ISDN telephone 12/14, see FIG. 1) comprising: a coupler (e.g., comprising network interface 42, see FIG. 3) accessing signaling channels (e.g., D-channels; signaling channel 46) to transmit signaling messages (e.g., message signaling via signaling packets, see col. 3, lines 8-42); an interpreter (e.g., CPU 40 in combination with ROM/RAM 52/54, see col. 3, lines 22-64) producing a signaling configuration (e.g., setup message, see col. 3, line 43 – col. 4, line 5) upon receiving an order to send a

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signaling message (e.g., an incoming call when in remote mode, see col. 3, lines 55-64; and a receiver (inherently within 12/14) for adding a receive flag (e.g., flag or code, see col. 4, lines 1-3) to a received signaling message, wherein the order (e.g., incoming call) is a predetermined constant character string (e.g., calling line ID, see col. 3, line 42 – col. 4, line 5). However, Hickey may not specifically disclose the signaling configuration produced depends on a type of one of a plurality of signaling channels accessible to the coupler.

Glass, like Hickey, also teaches ISDN communications (e.g., see abstract regarding “ISDN equipment”) and specifically, teaches that it is well known in the art that “Integrated services digital network (ISDN) communications enable telephone service providers to supply multiple types of signalling channels from a central office ... to a network termination or ISDN terminal equipment” (Glass at col. 1, lines 19-26). Additionally, the teachings of Glass provide improved ISDN communications for establishing calls at an ISDN terminal device (e.g., see Glass at col. 9, lines 42-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the ISDN teachings, recited by Glass to be well known in the art, to the ISDN terminal device of Hickey in order to provide improved ISDN communications for establishing calls at an ISDN terminal device (e.g., see Glass at col. 9, lines 42-53). However, while Hickey in view of Glass teach a plurality of signaling channels, they may not specifically disclose the signaling configuration produced depends on a type of the signaling channels accessible to the coupler.

Hartmann, like Hickey and Glass, also teaches ISDN communications (e.g., see col. 1, lines 31-61 regarding “ISDN”), and further, specifically teaches it is well known in the art that a signaling configuration (e.g., see col. 2, line 5 regarding “switch configuration commands”)

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produced may depend on a type of the signaling channels accessible to the coupler (e.g., see col. 2, lines 5-18 regarding “[t]ypical switch configuration commands ... include ... changing a channel configuration, [and] changing a trunk type configuration (defining the signaling protocol for a particular channel or group of channels)”. Additionally, the teachings of Hartmann provides ISDN communications which are improved by accommodating different protocols of a plurality of switches with reduced costs through simplified modular communication devices (e.g., see Hartmann at col. 1, line 21 – col. 4, line 19 regarding objects and advantages). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the ISDN communication teachings well known in the art as disclosed by Hartmann to the ISDN communications device of Hickey in view of Glass in order to provide ISDN communications which are improved by accommodating different protocols of a plurality of switches with reduced costs through simplified modular communication devices (e.g., see Hartmann at col. 1, line 21 – col. 4, line 19 regarding objects and advantages).

Regarding claim 3, Hickey teaches a switch as discussed above regarding claim 1, wherein the switch provides a method of sending a signaling message (e.g., message signaling via signaling packets, see col. 3, lines 8-42), comprising: adding to the signaling message a predetermined send order for the signaling message (e.g., an incoming call when in remote mode, see col. 3, lines 55-64), the adding further comprises the switch receiving the signaling message in a receiving exchange (e.g., see col. 3, line 22 – col. 4, line 5) and adding a receive flag (e.g., flag or code, see col. 4, lines 1-3) to the signaling message; and interpreting the send order in an interpreter (e.g., CPU 40 in combination with ROM/RAM 52/54, see col. 3, lines 22-64) of the switch to produce a signaling configuration (e.g., setup message, see col. 3, line 43 –

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col. 4, line 5) of the switch, the signaling configuration (e.g., setup message) produced depends on a type of signaling channels available to the switch (e.g., setup message depends on the signaling channel comprising a D-channel, see col. 3, lines 63-64), wherein the receive flag is a specified constant (e.g., flag or code, see col. 4, lines 1-3) and the predetermined send order (e.g., incoming call) is a specified constant character string (e.g., calling line ID, see col. 3, line 42 – col. 4, line 5).

Regarding claims 5 and 7, Hickey teaches the interpreter is configured, and comprises a circuit, to process at least a switched X25 protocol (e.g., see col. 1, lines 15-62).

Regarding claim 8, Hickey teaches the interpreter comprises one of a microprocessor associated with a program, and a working session in a processor running the switch (e.g., via CPU 40 in combination with ROM/RAM 52/54, see FIG. 3 and col. 3, lines 22-42).

8. Claims 2, 4, 6 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hickey in view of Glass in view of Hartman, further in view of U.S. Patent No. 5,949,871 to Kabay et al.

Regarding claims 2 and 4, Hickey in view of Glass in view of Hartmann teaches the switch and method discussed above regarding claims 1 and 3, however, may not specifically disclose a detector or translator.

Kabay also teaches a switch and a method for telecommunications, and specifically, teaches a coupler (e.g., intercept box) has a detector (e.g., implicitly done by database lookup) for recognizing whether a received signaling message is addressed to a switch (e.g., see col. 17, lines 12-15), and implicitly processing the message accordingly when the switch is the

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destination, and a translator (implicitly via the database operation) for replacing the receive flag (e.g., comprising location routing number, or LRN) with a predetermined character string (e.g., dialed number, or CdPN) when the switch is not the destination for the signaling message (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers). The teachings of Kabay provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in view of Glass in view of Hartmann in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Regarding claim 6, as discussed above regarding claim 8, Hickey teaches the interpreter comprises one of: a microprocessor associated with a program, and a working session in a processor running the switch (e.g., via CPU 40 in combination with ROM/RAM 52/54, see FIG. 3 and col. 3, lines 22-42).

Regarding claim 11, Hickey teaches when the signaling message is received by the switch, adding a receive flag (e.g., flag or code, see col. 4, lines 1-25) to the signaling message and checking the signaling message for the receive flag to determine whether the switch is a designated destination for the signaling message (e.g., see col. 4, lines 1-25 wherein upon detection of a flag, it is determined whether the call is from WAW telephone 12 and is correspondingly to be received by a WAW telephone such as WAW telephone 14).

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Regarding claims 12 and 13, as discussed above regarding claim 2, Kabay teaches a translator (via database operation) for replacing the receive flag (e.g., comprising location routing number, or LRN) with a predetermined character string (e.g., dialed number, or CdPN) if the switch is not itself the destination (e.g., see col. 7, lines 62-65 wherein the LRN will be the same as the original CdPN for non-ported customers), regardless of the signaling configuration or signaling message destination. The teachings of Kabay provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to apply the telecommunications switching teachings of Kabay to the telecommunication switching of Hickey in view of Glass in view of Hartmann in order to provide the implementation of improved services in a switched telecommunications network with increased efficiency and decreased cost (e.g., see col. 5, lines 46-53).

Allowable Subject Matter

9. Claims 9 and 10 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


10. The following is a statement of reasons for the indication of allowable subject matter: claim 9 comprises allowable subject matter for the reasons argued by applicant on pages 14-15 in the Remarks filed March 2, 2005; and claim 10 is dependent upon claim 9 and therefore comprises allowable subject matter for the same reasons as discussed above regarding claim 9.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Philpott whose telephone number is 571.272.3162. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham can be reached on 571.272.3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Justin M Philpott